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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,666	01/13/2003	Heather M. Hudson	5051-461XX	5677
20792	7590	10/20/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			HENDRICKS, KEITH D	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/030,666	HUDSON ET AL.
	<b>Examiner</b> Keith Hendricks	<b>Art Unit</b> 1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 August 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 45-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 45-50 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 51-56 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.   |

## DETAILED ACTION

### ***Election/Restrictions***

Newly submitted claims 51-56 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 51-56 are generic to a plurality of patentably distinct species comprising the use of proteins of any nature, source, function, or structure. This includes the use of the whey protein preparations of claims 45-50. However, since applicant has received an action on the merits for the originally presented invention (i.e., the use of the whey protein preparations of claims 45-50), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 51-56 are withdrawn from consideration as being directed to a non-elected invention, insofar as they read upon proteins other than the whey proteins of claims 45-50. See 37 CFR 1.142(b) and MPEP § 821.03.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 45-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (US PAT 5,654,019). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed August 03, 2004, have been fully considered but they are not persuasive. At page 6 of the response, applicant states that in Examples 10 and 11, a 3.0M NaCl solution is used to dissolve the protein preparation, whereas the instantly-claimed invention has a salt

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concentration of between 0 and 100mM. This is not deemed persuasive for the reasons of record. It is noted that in both examples 10 and 11, the preparations are subjected to desalting methods by reverse osmosis, and in example 10, Fraction I was electrodialyzed, which inherently results in a desalted product, as this is a function of electrodialysis. Note that the instant claims do not exclude these processes. See also the preparation methods of example 7. Thus, the methods and resulting preparations of examples 10 and 11 would clearly be expected to read upon the claimed invention.

Applicant also states that the reference “does not disclose using a protein gel to enhance water retention.” This is not deemed persuasive for the reasons of record. In response to applicant's argument, a recitation of the intended use or effect of the claimed invention must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use or providing the claimed effect, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, while the reference does not specifically disclose this aspect as an effect of the method, it would be considered an inherent property of the disclosed method, absent any clear and convincing evidence and/or arguments to the contrary.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langton et al., in view of Otte et al. (of record).

Langton is incorporated as cited in a previous Office action.

Otte et al. disclose the “effects of limited proteolysis on the microstructure of heat-induced whey protein gels at varying pH.” This is performed by the addition of proteases to whey protein preparations. At page 782, columns 1-2, Otte et al. state that “inclusion of whey proteins (WP) in food products as a functional ingredient for gelation is of increasing importance. Whey proteins have the ability to form

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heat-induced gels..." Further, reference is made to Langton and Hermansson (Langton et al.), and the whey protein gels produced therein.

Thus it would have been obvious for one of ordinary skill in the art to have utilized the teachings of Otte et al., regarding to the introduction of whey protein gels into foodstuffs, with the whey protein gel product of Langton et al. In the same paragraph, Otte et al. specifically refers the reader to Langton et al. Thus, one of ordinary skill in the art would have been amply motivated to utilize the whey protein gel products of Langton et al. within food compositions, for the various properties they provide. It is noted that the instant claims simply require "introducing said whey protein gel into a composition", and does not specify the type of composition. It is important to note that, given the teachings of Langton et al., it is apparent that applicant did invent the specific whey protein gels produced by the claimed method. Thus, the question of patentability comes down to whether one of ordinary skill in the art would have found it obvious to utilize the products of Langton in "compositions", in amounts "sufficient to enhance the retention of water in said composition", as instantly claimed. This has been accomplished by the teachings of Otte et al.

Applicant's arguments filed August 03, 2004, with regard to the 35 U.S.C. 102(b) rejection over Langton et al. alone, have been fully considered but they are not persuasive. At page 4 of the response, applicant states that "Langton et al. does not disclose or suggest using the protein gel produced therein in a composition to enhance the retention of water in the composition." This is not deemed persuasive for the reasons of record. In response to applicant's argument, a recitation of the intended use or effect of the claimed invention must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use or providing the claimed effect, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, while the reference does not specifically disclose this aspect as an effect of the method, it would be considered an inherent property of the disclosed method, absent any clear and convincing evidence and/or arguments to the contrary.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KEITH HENDRICKS  
PRIMARY EXAMINER